



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,571	07/09/2001	David Michael Shotton	117-352	6937

7590 01/21/2004
Nixon & Vanderhye
1100 North Glebe Road 8th Floor
Arlington, VA 22201-4714

EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,571

Applicant(s)

SHOTTON ET AL.

Examiner

Victor R. Kostak

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 7. 6) ☐ Other: _____

1. Claims 4-13 are objected to because of the following informalities: all of these claims recite a “*a method, device or source ...*” but refer back only to method claim 1. Therefore, they cannot refer to device and “source” claims 2 and 3, respectively. (It is noted that claim 2 refers to a “device” but these dependent claims refer to a method and device in the alternative only. Since the dependent claims only refer back to claim 1, the device claim in claim 2 cannot be in view as an option). Appropriate correction is required.

Applicant is also informed that the Office realizes claim 10 has been canceled rather than amended (unlike the remaining dependent claims which have all been amended).

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if claim 3 is intended to be presented as an apparatus claim or a method claim because the claim introduces a “source” (therefore implying an apparatus) but does not recite any hardware thereafter. It instead lists what appear to be steps in a method.

It is further pointed out that if an apparatus claim is intended, then the claim would be rejected under 35 USC 112 1st paragraph as reciting a “single means” claim (namely only the source). As decided in *In re Hyatt* (248 USPQ 195, CAFC 1983), “*the problem with a single means claims is that it covers every conceivable means for achieving (the) stated result, while (the) specification discloses at most only those means known to (the) inventor*”.

Art Unit: 2611

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Noda et al.

The system and method of Noda (noting particularly Figs. 1, 3A, 3B, 9A, 9B; other embodiments in Figs. 5 and 6) includes plural stations remote from each other arranged as a multi-point communication system (actual camera and display units per respective stations not shown). A user at one station specifies which remote image data (i.e. file data) is to be retrieved and customized to specific quality parameters (e.g. col. 2 line 37 – col. 3 line 17). The user selects a source to retrieve desired video data (i.e. file) and identifies parameters of the data (e.g. col. 3 lines 4-17), and at least spatial characteristics of the video data are customized by a filtering operation (col. 3 line 3; col. 4 line 34-37). As a result, the retrieved video file is presented to the local user's site as a customized image, thereby meeting claims 1-3.

As for claim 2, the parameters to be customized can be both spatial and temporal as Noda points out that the frame number (and therefore frame rate and temporal frequency) is to be adjusted when the spatial resolution is increased (thereby balancing the data rate, initially implied in col. 3 lines 12, specified in col. 4 lines 48-56).

Art Unit: 2611

Regarding claim 11, both video and audio quality is identified (col. 1 lines 11-15), the parameters thereof inherently identified in order to know how to customize the signals (parameters of the video explicitly addressed throughout the specification).

As for claim 12, plural remote users can simultaneously access the remote source (col. 14 lines 10-14).

Considering claim 13, the accompanying audio data is also identified as quality thereof addressed (col. 1 lines 11-15).

4. Claims 1 and 5 rejected under 35 U.S.C. 102(e) as being anticipated by Brusewitz et al. cited and provided by applicant). (Additional claims already rejected above could also be rejected herein but have not in order to avoid repetition).

The communication system and method of Brusewitz (Fig. 2) includes a source (camera) at a remote site relative to a user who accesses display device 66. An image file (i.e. video data captured by camera 44) is requested to be retrieved by the user with remote controller 78 but is first customized by virtue of a backchannel 75. Interface 68 and translator 70 communicate with control unit 54 at the remote source, wherein at least spatial characteristics of the image file are adjusted for transmission of a customized image to the user (e.g. col. 55-58), thereby meeting claim 1.

As for claim 5, spatial, temporal, and format parameters are customized (col. 3 lines 55-58; col. 5 lines 4-15).

Art Unit: 2611

5. Claims 1 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunt et al. (It is again noted that additional claims can also be rejected herein but have not for the purpose of minimizing repetition).

The communication system and method of Hunt (noting particularly Figs. 1B, 2, 7, 8, 11 and 12) includes a user end 104 which communicates with a remote server (source) 102, wherein image files desired to be downloaded are first customized by the user (Figs. 7, 8, 11 and 12). The user requests the image file from the server and prior to transmitting the file, the image is customized at least spatially (e.g. size, noting Fig. 11), thereby meeting 1.

As for claims 6 and 7, the source is an Internet server (noting Fig. 2).

As for claim 8, the users station includes a PC terminal.

Regarding claim 9, the server provides the user with programming to enable the customization (noting Fig. 11).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is 703 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on 703 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703 308-9306.

Application/Control Number: 09/831,571

Page 6

Art Unit: 2611

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

Victor R. Kostak
Primary Examiner
Art Unit 2611

VRK

